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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,492	02/14/2005	Michael J. Hamer	124-1105	8690
23117	7590	12/27/2005		
NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			EXAMINER BHATNAGAR, ANAND P	
			ART UNIT	PAPER NUMBER

2623

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/524,492	Applicant(s) HAMER ET AL.	
	Examiner Anand Bhatnagar	Art Unit 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02/14/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 57-87 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 57-87 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>05/06/05&02/14/05</u> . | 6) <input type="checkbox"/> Other: _____ |

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 57 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 2 of copending Application No.

10/274,358. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claims 58-62 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 6-10, respectively, of copending Application No. 10/274,358. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim 63 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 13 of copending Application No. 10/274,358. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claims 64-67 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 15-18 of copending Application No.

10/274,358. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claims 68-73 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 20-25 of copending Application No.

10/274,358. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claims 74-79 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 27-32 of copending Application No.

10/274,358. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim 80 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 37 and 38 of copending Application No.

10/274,358. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim 81 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 53 of copending Application No. 10/274,358.

This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claims 82-84 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 66-68 of copending Application No.

10/274,358. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim 85 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 72 and 73 of copending Application No. 10/274,358. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim 86 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 87 of copending Application No. 10/274,358. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim 87 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 100 of copending Application No. 10/274,358. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

2. Claims 57-87 are directed to the same invention as that of claims 1, 2, 6-10, 13, 15-18, 20-25, 27-32, 37, 38, 53, 66-68, 72, 73, 87, and 100, respectively, of commonly assigned application # 10/274,358 assigned to Qinetiq Limited. This instant invention's application and related application 10/274,358 have duplicate claims but the inventive entity does not match on the two applications. In the case of this instant invention there is an inventor, Margaret Varga, listed as an inventor but is not listed in the related application #10/274,358. If this inventor in question contributed to the invention then why is she not listed in the related application 10/274,358 since the claims are duplicate in both inventions? If she

did not contribute to this instant invention then why is she listed on this instant invention since the claims are duplicate in both inventions? The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved.

Since the U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

Failure to comply with this requirement will result in a holding of abandonment of this application.

Claim Rejections - 35 USC § 102

3. Claims 57-87 are provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending Application No. 10/274,358 which has a common assignee and at least one common inventor with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if published under 35 U.S.C. 122(b) or patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a

presumption of future publication or patenting of the copending application.
10/274,358.

This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131. This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

Contact Information


4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anand Bhatnagar whose telephone number is (571) 272-7416, whose supervisor is Jingge Wu whose number is (571) 272-7429, Central fax is 571-273-8300, and Tech center 2600 customer service office number is 703-306-0377.

AB

Anand Bhatnagar

Art Unit 2623

December 21, 2005


SAMIR AHMED
PRIMARY EXAMINER